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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,465	01/18/2005	Tadayoshi Iijima	264507US0PCT	2229
22850	7590	09/04/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
ZIRKER, DANIEL R				
ART UNIT		PAPER NUMBER		
1771				
NOTIFICATION DATE		DELIVERY MODE		
09/04/2007		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/521,465

Applicant(s)

IJIMA ET AL.

Examiner

Daniel Zirker

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The Examiner notes for the record that his earlier holding that the amended claims as now filed in this RCE application are distinguishable over the prior art of record took place (i.e. the Final Rejection mailed 3/14/07) before the Supreme Court decision of **KSR International Co. v Teleflex Inc.**, 550 US ___, 82 USPQ2d 1385 (April 30, 2007), which as applicants' are well aware has significantly changed the law of obviousness under 35 USC 103. Since a major element in the Examiner's earlier finding of patentability significantly involved the absence of any motivation in the primary reference for making the improved solvent resistance possessing structures exhibited by the articles of the claimed invention, which motivational statement is an issue that the **KSR** holding directly addresses, the Examiner believes that he is required to withdraw his earlier holding of allowability in view of the following prior art rejections set forth below.
3. Claims 1, 3-9, 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '306 machine translation taken in view of JP '791 machine translation. The references are again relied upon for their specific teachings as previously set forth during prosecution, with the prior art combination, primarily JP'306, believed to either substantially disclose or render obvious the claimed genres of articles, although as earlier stated (Paragraph No. 5 of the Final Rejection, Paper No. 20070306) JP '306 is silent in its disclosure as regards the alleged poor solvent resistance which applicants state that it possesses. The secondary reference, however, addresses the problem of

improved solvent resistance by including a suitable amount of a cellulosic resin such as nitrocellulose which functions as a solvent drying resin when, e.g. it is applied to a triacetyl cellulose film. Accordingly, while modifying the JP '306 disclosed genus of articles in the manner suggested by JP '791 is believed to enhance the solvent resistance of the primary reference articles by incorporating a suitable amount of such a cellulosic resin into the JP '306 structure, it is also believed to run afoul of the broad holding set forth in **KSR**. That is, the relevant holdings are believed to be summarized by the statements that an article is not believed to be patentable if it is formed by either combining prior art elements according to known methods to yield predictable results, or , perhaps more relevantly, it is formed by simple substitution of a known element for another to obtain a predictable result. In the present application the primary reference genus of articles are treated to improve their resulting solvent resistance by modifying their structures by incorporating into their adhesive layer elements including a suitable cellulosic resin that is taught by the secondary reference as improving the resultant article's solvent resistance and thereby obtaining what the Examiner clearly believes is a very predictable result from the teaching of the secondary reference, JP '791, namely laminated articles having improved solvent resistance together with their previously desirable properties. As regards those dependent claims which the Examiner did not reject on prior art grounds in the Final Rejection the Examiner does not now believe that stating in the independent claim that the cellulose resin "has an ester bond" is a suitable distinguishing characteristic, and the remaining dependent claims are believed to be

suitably treated in the manner set forth in Paragraph No. 4 of Paper No. 061206, the initial Office Action in the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday - Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Daniel Zirker/
Primary Examiner, Art Unit 1771